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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,020	03/27/2001	Bradley R. Schaefer	IRI05428	9727
22863	7590	11/01/2004	EXAMINER	
MOTOROLA, INC. CORPORATE LAW DEPARTMENT - #56-238 3102 NORTH 56TH STREET PHOENIX, AZ 85018			WONG, BLANCHE	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,020

Applicant(s)

SCHAEFER ET AL.

Examiner

Blanche Wong

Art Unit

2667

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 3-9 and 11-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because misspelling. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

With regard to drawing, Applicant is requested to replace – CPMMON – with "COMMON" in 105 of Fig. 2.

Specification

2. The disclosure is objected to because of the following informalities:

- On p.1, Applicant is requested to provide the correct application serial no. in ln. 7
- On p.7, Applicant is requested to add the word “negotiated” to read “If the negotiated formats are homogeneous” in ln. 30, in order to be more consistent with the rest of the specification.
- On p.8, Applicant is requested to introduce block/process 140 in ln. 22, before beginning with block 141-149, in order to be more consistent with the rest of the specification.
- On p.9, Applicant is requested to replace – Is – with “is” in ln. 2.
- On p. 12, Applicant is requested to replace – moise – with “noise” in ln. 23.

Appropriate correction is required.

Claim Objections

3. Claims 4,6,17,20 are objected to because of the following informalities:
- With regard to claims 4 and 6, Applicant is requested to add the word “terminal” or “user terminal” after – a second – both in ln. 5.
 - With regard to claims 17 and 20, Applicant is suggested to add the wording “of the plurality of user terminals” after – the first user terminal – in ln. 8-9 and ln. 10 respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 19, it is unclear what is internet protocol coupling.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1,2,10,16,19,20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Pat No. 6,771,639) in view of Caugherty (U.S. Pat No. 6,597,702).

With regard to claims 1,10,16, Holden discloses sending SIP request to perform call requests, col. 4, ln. 47 (originating an internet protocol call using SIP) and coupling to the data network, col. 6, ln. 8 (coupling a data input/output of each of the plurality of user terminals to a conference bridge). However, Holden fails to explicitly show negotiating by the plurality of user terminals a common bearer format among the plurality of user terminals.

In an analogous art, Caugherty discloses the calling endpoint sends notification to the called endpoint that it has different codec, col. 2, ln. 62-67, and the called endpoint chooses one of the codec capabilities proposed by the calling endpoint, col. 3, ln. 5-7.

A person of ordinary skill in the art would have been motivated to employ Caugherty in Holden in order to have negotiation by the user terminal. The suggestion/motivation to do so would have been to provide for fast call setups. Caugherty, col. 3, ln. 66. At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine Holden and Caugherty to obtain the invention as specified in claims 1,10,16.

With regard to claim 2, Holden further discloses a packet-switched data network 12 (see also col. 3, ln. 39-40).

With regard to claim 19, Holden discloses the conference bridge arrangement as claimed in claim 16. However, Holden fails to explicitly show signaling coupling that includes internet protocol coupling, as recited in claim 19.

Voice over IP can be an internet protocol coupling.

A person of ordinary skill in the art would have been motivated to have internet protocol coupling in Holden in order to have VoIP. The suggestion/motivation to do so would have been to provide for VoIP telephony calls. At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which

the invention pertains to combine Holden in view of obviousness to obtain the invention as specified in claim 19.

With regard to claim 20, Holden further discloses SIP. Col. 4, ln. 45.

8. **Claims 17,18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden and Caugherty as applied to claims 1,2,10,16,19,20 above, and further in view of Dorenbosch (U.S. Pat No. 6,697,614).

With regard to claims 17, the combination of Holden and Caugherty discloses a conference bridge. However, the combination fails to explicitly show a mobile hand set, as recited in claim 17:

In an analogous art, Dorenbosch discloses mobile devices 201-204 in Fig. 1.

A person of ordinary skill in the art would have been motivated to employ Dorenbosch in Holden and Caugherty in order to include mobile devices. The suggestion/motivation to do so would have been to provide for a conference bridge that hears all participants, but transmits only one selected participant. Dorenbosch, col. 1, ln. 28-29. At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine Dorenbosh, Holden and Caugherty to obtain the invention as specified in claim 17.

With regard to claims 18, the combination of Holden and Barany discloses a conference bridge. However, the combination fails to explicitly show a processor, as recited in claim 18.

In an analogous art, Dorenbosch discloses a processor 104 in Fig. 1.

A person of ordinary skill in the art would have been motivated to employ Dorenbosch in Holden and Caugherty in order to include a processor. The suggestion/motivation to do so would have been to provide for a conference bridge that hears all participants, but transmits only one selected participant. Dorenbosch, col. 1, ln. 28-29. At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine Dorenbosch, Holden and Caugherty to obtain the invention as specified in claim 18.

Allowable Subject Matter

9. Claims 3-9,11-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

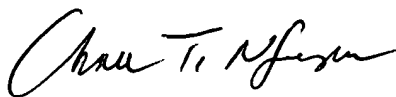
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blanche Wong whose telephone number is 571-272-3177. The examiner can normally be reached on Monday through Friday, 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BW

BW
October 18, 2004



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